No. 815

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IN THE

Supreme Court of the United States

OCTOBER TERM 1943

PHILIP ZALKIND,

Petitioner,

v.

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION, MASELL MANUFACTURING CORPORATION,

Respondents,

and

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION,

Respondents,

v.

GUIDE SYSTEM & SUPPLY CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.



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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable, The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Philip Zalkind, prays that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit rendered December 10, 1943, affirming judgment of the District Court for the Southern District of New York rendered February 25, 1943. That judgment dismissed a portion of petitioner's claim for relief on the merits and before trial.

I

Jurisdiction

Jurisdiction is based on Section 240(a) of the Judicial Code as amended; 28 U. S. Code 347.

The order for mandate of the Circuit Court of Appeals was entered December 29, 1943 (Rec. p. 116).

II

Opinions Below

The District Court dismissed that portion of the complaint which alleged misuse of Patent Office interference proceedings to delay issue of plaintiff's patent and which sought damages for the period of such delay (Rec. p. 76) in a decision reported at 57 U. S. P. Q. 104 and not officially reported. This decision was based on a prior decision of the same court (Rec. p. 67) reported at 49 Fed. (Supp.) 753. The opinion of the Circuit Court of Appeals affirming the decision of the District Court is reported at 139 Fed. (2) 895 (Rec. p. 91).

III

Summary Statement of Matter Involved

This is a petition for a writ of certiorari to review the dismissal before trial for lack of jurisdiction of a portion of the claim for relief in a suit in equity for an injunction and accounting under U. S. Letters Patent No. 2,118,011, 2,233,906 and 2,245,026.

There is no diversity of citizenship.

The amended complaint charges infringement and a course of conduct on the part of the defendants based on

misuse of interference proceedings to delay the issue of plaintiff's patents for years (Rec. p. 72); and asks for damages from the time plaintiff's patents would have issued but for the delay wrongfully caused by defendants and for three-fold damages (Rec. p. 73).

Petitioner asserts that he is entitled to demonstrate at the trial that he can prove the entire cause of action, including both claims for relief, with only the facts necessary to establish the patent infringement claim.

The Circuit Court of Appeals for the Second Circuit (with a minority dissent) has assumed without any warrant in the record or pleadings before it and entirely on supposition that the character of defendant's wrongful acts in misusing interference proceedings to delay issue of plaintiff's patents must necessarily require proof beyond the record in the interference (Rec. p. 104).

On the basis of this unsupported assumption, the Court below dismissed that portion of the complaint alleging misuse of interference proceedings to delay issue of plaintiff's patents and seeking damages for the period of such delay.

This decision was based entirely on the case of *Hurn* v. *Oursler*, 289 U. S. 238.

Assuming for this appeal that a cause for damages for wrongful misuse of interference proceedings, in the absence of diversity, is not a Federal matter,—

IV

The Questions Presented Are:

1. Where a plaintiff brings a patent infringement action and joins therewith a claim for damages for wrongful misuse of interference proceedings, may a Court dismiss the additional non-federal claim before trial on the pleadings only and on the basis of a supposition that the proof will go beyond the federal claim?

2. Can the Court in such a case make an assumption before trial that the proof for the two claims will not be substantially identical?

3. Must the plaintiff in such a case, to avoid such an assumption, allege in his complaint evidentiary matter to negative that assumption?

4. May these claims in such case be joined where only the evidence admissible on the patent infringement claim (which included the interference record) is relied on to prove the claim for wrongful misuse of interference proceedings?

5. Where the jurisdiction of the Court depends on the evidentiary facts, may the Court dismiss for lack of jurisdiction before trial?

And, finally:

6. Is a claim for relief for fraudulent utilization of interference proceedings to delay the issue of an inventor's patent so that a wrongdoer may without consent of the inventor, after the filing of the inventor's application, make use of the invention for an extended period of time constitute a claim within the purview of jurisdiction of the Federal Courts in view of: Title 28, U. S. Code, Section 41, subsection 7; Title 28, U. S. Code, Section 371, subsection 5; Title 35, U. S. Code, Section 52; and Title 35, U. S. Code, Section 48?

V

Reasons for Granting the Writ

The jurisdictional question involved requires an interpretation of the doctrine of the *Hurn* v. *Oursler* case, 289 U. S. 238, with respect to which there have been many divergent and unreconcilable decisions in the various circuits.

Various decisions in the various circuits, applying the rationale of the opinion in the *Hurn* v. *Oursler* case, have reached conflicting views: Some Courts have applied the rule liberally allowing any substantially interwoven federal and non-federal claims to be tried together (*E. Edelmann & Co.* v. *Triple-A Specialty Co.*, 88 F. [2] 852, C. C. A. 7; *Hemmeter Cigar Co.* v. *Congress Cigar Co., Inc.*, 118 F. [2] 64, C. C. A. 6; *Atkins* v. *Gordon*, 86 F. [2] 595, C. C. A. 7). The Second Circuit has applied the rule of *Hurn* v. *Oursler* to distinguish the chief holding thereof on only slightly dissimilar facts. Thus, for instance, in a discussion of the effect of the rule of *Hurn* v. *Oursler* in volume 52 of the Yale Law Journal at page 922, a statement is made at page 924:

> "Not only is there disharmony among the rulings of the several circuits on this same issue, but rulings by different judges in the same circuit are sometimes not in strict rapport. Particularly difficult to reconcile are the decisions of the Second Circuit" (*Treasure Imports* v. *Amdur*, 127 F. [2] 3; *Musher Foundation* v. *Alba Trading Co.*, 127 F. [2] 9, cert. den. 317 U. S. 641; *Pure Oil Co.* v. *Puritan Oil Co.*, 127 F. [2] 6).

Moore's Federal Practice, Volume 1, in the 1942 supplement, at page 83 states:

> "The Second Circuit rule—In Lewis v. Vendome Bags (C. C. A. 2d, 1939), 108 F. (2) 16, cert. den. (1940) 309 U. S. 660, 60 S. Ct. 514, 84 L. Ed. 1008, the Second Circuit purports to follow Hurn v. Oursler, but its decision is based on a very restrictive concept of cause of action for jurisdictional purposes. It is proper to make the same criticism of Musher Foundation v. Alba Trading Co. (C. C. A. 2d, 1942, 127 F. [2] 9, cert. den. 1942, U. S. , 63 S. Ct. 33, 87 L. Ed.)"

In all of the cases that have been decided pursuant to the rule of *Hurn* v. *Oursler*, the Appellate Court had an opportunity to study the entire question of jurisdiction with relation to the facts and the evidence as brought out at

a trial. Thus, the Appellate Court was fully equipped to determine whether or not the jurisdictional facts of the claims for relief involved fell within the *Hurn* v. *Oursler* doctrine.

This is the first case brought to this Court where an attempt has been made to apply the *Hurn* v. *Oursler* doctrine before trial in the absence of such facts as might be brought out by the evidence to assist in a determination of jurisdiction.

Apart from the prime necessity for so emphasizing or restating the *Hurn* v. *Oursler* doctrine that it will be applied uniformly in all jurisdictions, the following additional important and novel question is presented by this appeal: May a Court in following the *Hurn* v. *Oursler* doctrine, to determine whether or not jurisdiction of the non-federal claim for relief may be retained, make a determination with respect to jurisdiction under that doctrine before trial and in the absence of any evidence on the basis of which it may determine that the jurisdictional facts fall within or entirely outside of the *Hurn* v. *Oursler* doctrine?

The determination of this question, in addition to considerations of uniformity in the various jurisdictions, render the present issue of national importance, for if such a determination may be reached before trial, the rule of the *Hurn* v. *Oursler* case is nullified.

Wherefore petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the Circuit Court of Appeals for the Second Circuit commanding that Court to certify and to send to this Court for its review and determination on a day certain to be named therein a full and complete transcript of the record and of the proceedings in the case numbered and entitled on its dockets "No. 94 October Term, 1943, Philip Zalkind, Plaintiff-Appellant, against Sol Scheinman, Jacob Mandel, Pronto File Corporation, Masell Manufacturing Corporation, Defendants-Appellees, and Sol Scheinman, Jacob Mandel, Pronto File Corporation,

Third Party Plaintiffs, against Guide System & Supply Co., Inc., Third Party Defendant", and that the decision of the said Circuit Court of Appeals in said case and of the District Court be reversed and the additional claim for relief be reinstated, and that your petitioner have such other and further relief as in the premises may be just.

PHILIP ZALKIND,
Petitioner.
By SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.

Certificate

We hereby certify that we have examined the foregoing petition, that in our opinion it is well founded and entitled to the favorable consideration of the court, and that it is not filed for the purpose of delay.

SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.